

### **REMARKS**

This application has been reviewed in light of the Office Action mailed on August 14, 2006. Claims 1-23 are pending in the application with Claims 6 and 9-20 being previously withdrawn and with Claims 1 and 21-23 being in independent form. Claims 1 and 21-23 have been amended by this response. The amendments to Claims 1 and 21-23 further define the “substantially rigid material” (in response to the Examiner’s comment in the second paragraph of Page 10 of the Office Action). Thus, Applicants believe that no additional examination is required and these amendments should be fully considered. In view of the amendments and following remarks, reconsideration and allowance of this application are respectfully requested.

### **Rejections under 35 U.S.C. §112, ¶1**

In the Office Action, Claim 22 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. It was asserted that Applicants have not provided support for the offset distance X being in the range of about 0.005 inches to less than 0.04 inches. In Applicants’ disclosure, in the first full paragraph of page 15, it is states that, “in accordance with the present disclosure, distance ‘X’ is from about 0.005 inches to about 0.200 inches.” Applicants contend that the claimed range of about 0.005 inches to less than 0.04 inches is within the range of about 0.005 inches to about 0.200 inches. Thus, Applicants’ disclosure complies with the enablement requirement with respect to Claim 22 and Applicants respectfully request withdrawal of this rejection.

**Rejections under 35 U.S.C. §102(b)**

Claims 1-3 were rejected under 35 U.S.C. §102(b) by U.S. Patent No. 6,086,586 to Hooven. Hooven relates to a bipolar tissue grasping apparatus and tissue welding method.

In the final paragraph in the Response to Arguments section of the Office Action, it is noted that the term “substantially” is a relative term as used to describe the rigidity of the jaw members of Applicants’ disclosure. Applicants have hereby amended Claim 1 to define the term “substantially.” More specifically, Applicants have included the meaning of “substantially” as it relates to the rigidity of the jaw members by amending Claim 1 to recite, “wherein the substantially rigid material of the jaw members resists deformation when the force used to close the jaw members is between about 40 psi to about 230 psi.” This material is disclosed in the first paragraph of page 13 of Applicants’ disclosure: “Each jaw member 110, 120 is manufactured from a sufficiently rigid material (i.e., stainless steel) which is resistant to deformation as a result of clamping forces acting thereon.” Hooven does not disclose jaw members having this feature.

In the Office Action, it is asserted that the jaw members of Hooven are made from a material that is deformable or compressible upon exertion of the jaw member closure force. More specifically, on Page 3 of the Office Action, it is asserted that Column 4, lines 46-49 of Hooven disclose that the jaw members are made from a substantially rigid material. This paragraph of the Hooven reference refers to insulating members 52 and 54. (The correct reference numbers of the insulating members of Hooven are 50 and 52; reference number 54 indicates tissue (see column 4, lines 32-33)). Further, the following paragraph of the Office Action asserts that reference numbers 50 and 52 refer to an elastomeric material, which is compressible. Thus, the Office Action asserts that jaw members 50 and 52 of Hooven are both

substantially rigid and compressible. Accordingly, for at least the reason that the jaw members of Hooven cannot be both compressible and “substantially rigid,” as defined in Applicants’ claim, Applicants respectfully request withdrawal of this rejection and earnestly seek allowance of Claims 1-3.

Claim 8 was rejected under 35 U.S.C. §102(b) or, alternatively under 35 U.S.C. §103(a) over Hooven. For at least the reasons Claim 1 is believed to be patentable over Hooven, Applicants believe that Claim 8, which depends from Claim 1, is also patentable. Accordingly, Applicants respectfully request withdrawal of this rejection.

**Rejections under 35 U.S.C. §103(a)**

Claims 4-5 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hooven in view of U.S. Patent No. 5,496,312 to Klicek. Klicek discloses an impedance and temperature generator control. For at least the reasons Claims 1-3 are believed to be patentable, Applicants respectfully request withdrawal of this rejection and allowance of Claims 4-5 and 7, which depend from Claim 1.

Claims 21-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hooven. Claims 21-23 have been amended similarly to Claim 1, as described above. Thus, Applicants believe Claims 21-23 are allowable for at least the reasons Claim 1 is allowable over Hooven and Applicants respectfully request withdrawal of this rejection.

**CONCLUSION**

In view of the foregoing amendments and remarks, it is respectfully submitted that all claims presently pending in the application, namely Claims 1-5, 7-8 and 21-23, are believed to be in condition for allowance.

If the Examiner should have any questions concerning this communication or feels that an interview would be helpful, the Examiner is requested to call the Applicants' undersigned attorney at the Examiner's convenience.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted,



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